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EXAMINER
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ABDI, KAMBIZ

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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/745,205  
Filing Date: December 21, 2000  
Appellant(s): MENEZ ET AL.

**MAILED**

**JAN 29 2007**

**GROUP 3600**

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Reitseng Lin  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 13, 2006 appealing from the Office action mailed  
July 26, 2005

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. However, the applicant made amendments to claims 1-4 to overcome the rejected claims 1-4 under 35 U.S.C. 101 after the final rejection mailed on July 26, 2005. The examiner withdraws the rejection of claims 1-4 under 35 U.S.C. 101 based on the after final amendments made by the applicant in order to reduce the burden on the board as well as compactness of the prosecution.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,559,871	Smith et al.	9-2000
6,067,564	Urakoshi et al.	5-2000
5,710,901	Stdghill et al.	1-1998

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**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,559,871 to David B. Smith and U.S. Patent No. 6,067,564 to Akira Urakoshi et al. further in view of U.S. Patent No. 5,710,901 to Scott A. Stodghill.

3. As per claims 1, 11, and 12, Smith clearly discloses a method and a system for controlling user spending of a user purchasing television programs in a television apparatus, comprising the steps of:

- Detecting a first\_user request; providing a plurality of selectively actuatable entries for user spending limits each entry being associated with a different-length time period, in response to the first user request (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62);
- Receiving user selection of at least one of the entries and a spending limit for each selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62);
- and
- Tracking a second user request to purchase a television program during the time period associated with each selected entry (See Smith abstract, figures 2-10 and associated text,

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column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62); and

- Notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68).

What Smith is not specific is controlling user spending of purchasing television programs.

However, Urakoshi clearly teaches the limitation of spending control for purchasing television programs for multiple users and tracking such use of allotment (See Urakoshi abstract, figures 3, 4, 6, and 11, column 2, lines 9-30 and column 5, lines 40-49). The comparison of limits of the shorter time period and the longer time period and generating a warning is considered error detection and data validation as well. However, Urakoshi clearly teaches the control steps for time limit on spending and comparing the actual spending and the set limits as well as the budget that is designated (longer period spending) (See Urakoshi abstract, figures 3, 4, 6, and 11, column 2, lines 9-30, column 4, lines 42-68, and column 5, lines 1-3 and lines 40-49). In addition, it is examiners understanding that one cannot spend for example \$100 for a period of one day when the total spending limit for a month is set to be no more than \$50 within the same month. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to add the step and limitation of comparing the shorter period spending with longer period spending to be incorporated within Smith or Urakoshi teachings to avoid over spending.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Smith teaching with Urakoshi teachings to have better control and management of the charges to one having a subscription to a portal system such as pay-per-view or cable program purchasing.

Additionally Smith is not specific on;

determining if the spending limit for a shorter time period is greater than the spending limit for a longer time period if more than one of the entries is selected;

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Providing a user warning if the spending limit for the shorter time period is greater than the spending limit for the longer time period; (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62). However, Stodghill clearly discloses the entering of data by users can be containing errors. To alleviate such errors in data entry before the usage of data, rules and controls called validation procedures are implemented to prevent errors further in the system utilization of such entered data (See Stodghill abstract, column 1, lines 5-45, column 3, lines 39-47, and column 5, lines 8-18). It should be also emphasized that one skilled in the art at the time of the invention would know the importance of the data entry and data validation at the time of such entry, and to program the system in a manner to prevent the entry of data that might result in error in the algorithm of the calculation such as entering of amount for a short period of time that is greater than the amount entered for a longer period of time, which would result in an erroneous result for the users controlled spending. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to implement the data entry and validation controls of the Stodghill within the Smiths and Urakoshi system for prevention of invalid data entry as well as enhanced control over data entry by the users.

4. As per claim 2, Smith, Urakoshi and Stodghill teach all the limitations of claim 1, further; Smith teaches,

the step of providing a selection for a rolling time period (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

5. As per claim 3, Smith, Urakoshi and Stodghill teach all the limitations of claim 1, further; Smith teaches,

The step comprises of generating a user warning (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

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6. As per claim 4, Smith, Urakoshi and Stodghill teach all the limitations of claim 1, further;

Smith teaches,

the step of allowing the user to override the user spending limit (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

#### **(10) Response to Argument**

As per arguments put forward by the appellant the examiner would like to submit that the argument is unpersuasive: Limitation(s) in Preamble in response to applicant's arguments, the recitation "user purchasing **television programs**" has not been given patentable weight because the recitation occurs in the preamble of claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It should be noted that the fact that a television program is purchased or a service is obtained does not render the claims any different in their functions as they have been currently written. Further, In response to appellant 's argument that Smith '871 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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In this case, As it has been clearly articulated by the appellant in the specification, the problem to be solved is "to prevent excessive spending" and additionally controlling such spending limits based on a time limit such as a daily, weekly or monthly time period (See Specification page 1, lines 15-22) that is clearly thought by the prior art of record as being the case. Limiting the spending limits of users based on a amount limit and further on a daily, weekly or monthly time period (See Smith '871 column 4, lines 31-47).

Examiner disagrees with the appellant's characterization of the office action and how the prior art s have been combined as well as the motivation to combine. As it has been clearly stated by the appellant in the specification, as mentioned above, the thrust of the invention as follows "the present invention allows a user to specify a spending limit that is based on a selected period, instead of or in addition to per event basis" (Specification Page 1). As well as, the appellant is specifically concerned with solving the problem of controlling the spending limits. So the main concern of the invention is the control of the spending, not the specific system that it is used by. As it has been clearly stated "The determination that a reference is from a non-analogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In re Wood, 599 F2d 1032, 202 USPQ 171, (CCPA 1979).

The base prior art used in the rejection of the claims under 35 U.S.C. 103 might not be in the same exact environment as the appellant's claimed, however, the problem stated by the applicant to be resolved is the same as the stated problem to be solved by the prior art. As per above discussion the art used by the examiner is correctly sighted and is permissible to be used in a 35 U.S.C. 103 rejection of the currently presented claims based on the appellant's proposed claimed language as to be related to a method, system and apparatus for controlling user spending. Also, it should be understood that the secondary art, Urakoshi '564, used in combination with Smith '871 is clearly in the same environment as the appellant's broadcasting and TV programming. Again as per argument of the appellant over the permissible use of prior art Stodghill '901, examiner submits that the same rational as above is applicable to the argument that validation of data entered into a computer database is not related to any particular



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data. For example once computer programmer is asked to program a computer to limit the spending account of a user, the programmer is not concerned about which environment the validation is used. The programmer would be concern how this validation is used and whether the data entry can be prevented if such entry would cause errors within the database. It would be beneficial for the computer programmer to know what area or environment the database is going to be used to account for the nuances of the particular usage. Additionally, it would be only commonsense to have a preventive measure to prevent spending more money than what is allowed within a certain period of time. For example; if the sending limit for the month is set as \$100 and a weekly spending of \$25, it would have been only logical to have a computer algorithm that controls that the weekly spending would not exceeding the \$100 monthly and if the entry for the weekly limit is \$35 it detects an error and notifies the user.

Furthermore, as per independent claims 11 and 12, appellant argues that Smith, Urakoshi, and Stodghill do not teach, "controlling user spending..." as recited in claims 11-12.

The Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. The *Donaldson* decision affects only the manner in which the scope of a "means or step plus function" limitation in accordance with 35 U.S.C. 112, sixth paragraph, is interpreted during examination. *Donaldson* does not directly affect the manner in which any other section of the patent statutes is interpreted or applied.

The USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850. The Federal Circuit has held that applicants before the USPTO have the opportunity and the obligation to define their inventions precisely during proceedings before the PTO. See *In re Morris*, 127 F.3d 1048, 1056- 57, 44 USPQ2d 1023, 1029- 30 (Fed. Cir. 1997) (35 U.S.C. 112, second paragraph places the burden of precise claim drafting on the applicant); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation

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*Indus., Inc.*, 126 F.3d 1420, 1425, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (patentee who had a clear opportunity to negotiate broader claims during prosecution but did not do so, may not seek to expand the claims through the doctrine of equivalents, for it is the patentee, not the public, who must bear the cost of failure to seek protection for this foreseeable alteration of its claimed structure). See MPEP 2181.

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for";
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

As per claims 11 and 12, applicant's contentious portion of the claim recites: "means for providing a plurality of selectively actuatable entries for user spending limits with each entry being associated with a different-length time period," The claim uses the phrase "means for" modified by functional language, namely, "in response to a first user request," and fails to modify the "means for" phrase by sufficient structure material or acts for achieving the specified function.

- Smith clearly discloses providing a plurality of selectively actuatable entries for user spending limits with each entry being associated with a different-length time period, means, "Fig. 1, elements 1, 3, and 5 enables a user/customer/member to input proposed limits and length of time associated with such limit (column 4, lines 31-47)." Furthermore,
- Receiving means of Smith, "Receiving user selection of at least one of the entries and a spending limit for each selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).
- Tracking a second user request to purchase a television program during the time period associated with each selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62); and

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- Notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68).

Thus, the prior art at a minimum clearly performs the function as recited in the claim; no definition in the specification excludes the prior art element as an equivalent, therefore the prior art element is actually an equivalent of the means plus function as recited in the above referenced claims. Accordingly, the rejection of claims 11 and 12 are permissible and correct.

Therefore, the previous rejections of claims 1-4 and 11-12 are maintained under 35 USC § 103(a) rejections.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 17, 2007

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